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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,157	01/24/2001	Edward O. Clapper	42390P10898	5252
21906	7590	10/15/2004	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			RAMAKRISHNAIAH, MELUR	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,157

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Melur Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 57-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 57-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-30-2004 has been entered.

Specification

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an enabling disclosure.

Claim Rejections - 35 USC § 112

2. Claims 1-20, 57-60, 70-75, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 1 recites the limitation: in response to finding the clip, identifying a start point of the first portion; and storing the first portion of the media stream from the start and including the clip. There is no adequate disclosure in the

specification how this is accomplished or realized. For example limitation in claim 1 "finding the clip in media stream at a second time later than the first time" takes a finite amount of time. As an example, say a clip of a song is stored in the memory at a first time (at first broadcast of the song) and as a further example suppose radio station rebroadcasts the same song at a latter time. According to applicants claim 1, in order to find the clip that is stored in the memory at a first time and identifying the same clip at the second time latter than the first time when the same song is rebroadcast takes finite amount of time, and further identifying a start point of first portion takes some more time. In view of this, the claim limitation of claim 1 "storing the first portion of the media stream from the start and including the clip" has no support in the disclosure in the specification because finding the clip and identifying the start point takes finite amount of time and by this time rebroadcast of the song (as an example) would have progressed and in order to store the song and including the clip from the start would be impractical according to present disclosure of the specification. Therefore, there is no support in the disclosure for claimed limitation of claim 1.

Indepdent claims 14 and 70 have similar claim limitations as independent claim 1.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-4, 6, 8-11, 14-15, 17-18, 20, 57,60, 70-72 are rejected under 35 U.S.C 102(b) as being anticipated by Nishiuchi (JP 05-089558).

Regarding claims 1, 14, Nishiuchi discloses method and apparatus comprising: storing a clip of media stream at a first time, the clip less than all of first portion of the media stream, finding the clip in the media stream at a second time latter than the first time, and in response to finding the clip (in this case say, theme music broadcast, paragraph: 0005), identifying a start point of a first portion (this is implicit in as much as the reference teaches after identifying the theme music and comparing it that stored in the memory of the same theme song, and when there is an agreement, it implicitly identifies start point of the main program, paragraphs: 0007-0008) storing the first portion of the media stream from the start and including the clip (Drawings: 1-3, paragraphs: 0005-0009), a receiver (Drawing 1) to receive media stream, a capture trigger to designate a clip of media stream, a storage system (4, Drawing 1) coupled to the receiver to store the clip and a processing system (8, Drawing 1) coupled to the

storage system to search for the clip in the media stream after storage of the clip, and in response to finding the clip (in this case say, theme music broadcast, paragraph: 0005), identify a start point of block including the clip and store the block from the start (Drawings:1-3, paragraphs: 0005-0009).

Regarding claim 70, Nishiuchi further teaches an article comprising machine readable storage medium containing instructions that if executed enable a system to: store a clip of media stream at a first time, the clip less than all of a first portion of the media stream, find clip in the media stream at a second time latter than the first time, in response to finding the clip (in this case say, theme music broadcast, paragraph: 0005), identify a start of the first portion (this is implicit in as much as the reference teaches the following: after identifying the theme music and comparing it that stored in the memory of the same theme song, and when there is an agreement, it implicitly identifies start point of the main program, paragraphs: 0007-0008) and store the first portion media stream greater than and including the clip (Drawings: 1-3, paragraphs: 0005-0009).

Regarding claims 2-4, 6, 8-11, 15, 17-18, 20, 57, 71-72, Nishiuchi further teaches the following: performing digital signal processing upon a window of the media stream to produce digital signal processing window result, comparing the digital signal processing window result to the digital signal processing clip result (paragraphs: 0006-0007), identifying an end portion of the first portion from the media stream (note this is implied by identifying the end of the theme song (paragraph: 0008), and storing the media stream from the start point to the end point, again finding the clip in the media stream, and storing another portion of the media stream greater than and including clip, media

stream comprises audio, media stream comprises video, media stream comprises television, receiving parameters, and wherein at least one of finding and storing are responsive to parameters, parameters comprise at least one of: an estimated time into the first portion that a trigger was activated, a length of possible block to watch, etc (Drawings: 1-3, paragraphs: 0005-0009), a block manager in (8, Drawing: 1) to store a block of media stream to storage system, the clip is a subset of the block, the receiver is coupled to receive the media stream over a wireless broadcast channel, an output device (6, Drawing: 1) coupled to the receiver to play the media stream, processing system comprises a block manager in (8, Drawing: 1), the block manager containing instructions that, if executed enable the processor to locate at least a one block of media stream, the block including the clip, storage comprises a clip storage (4, Drawing: 4) to store the clip, block storage (6, Drawing: 1) to store one or more blocks, stream storage (6) to store media stream (Drawings: 1-3, paragraphs: 0005-0009).

2. Claims 61-66, are rejected under 35 U.S.C 102(e) as being anticipated by Honma (JP 2000-312323).

Regarding claim 61, Honma discloses a method comprising: storing a clip of the media stream at a first time, at a time latter than the first time, finding one or more blocks in the media stream, the one or more blocks including the clip, selectively comparing the two blocks (fig. 1, abstract and fig. 4-5, paragraphs: 0025-0028).

Regarding claims 62-65, Honma further teaches the following: finding one or more blocks includes identifying the clip in the media stream, storing the one or more blocks, based on comparison selecting better of the blocks, discarding the block that

was not selected, storing the one or more blocks includes identifying a start point and an end point of a given block in the media stream and storing the media stream from the start point to the end point (fig. 1, abstract and fig. 4-5, paragraphs: 0025-0028).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 58-59, 73, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiuchi in view of Honma (JP 2000-312323).

Regarding claims 5, 58, 73, Nishiuchi does not teach the following: comparing the first portion to other portion, and discarding one of the portions, based on comparison, enable the block manager to compare a first block and a second block, and to discard one of the blocks, based on comparison selecting a better of the blocks, discarding the block that was not selected, instructions to enable the system to compare the first portion, and discard one of the portions based on the comparison.

However, Honma discloses a program reservation video recording apparatus which teaches the following: comparing the first portion to other portion, and discarding one of the portions, based on comparison, enable the block manager to compare a first block and a second block, and to discard one of the blocks, based on comparison selecting a better of the blocks, discarding the block that was not selected, instructions

to enable the system to compare the first portion, and discard one of the portions based on the comparison (fig. 1, abstract and fig. 4-5, paragraphs: 0025-0028).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: comparing the first portion to other portion, and discarding one of the portions, based on comparison, enable the block manager to compare a first block and a second block, and to discard one of the blocks, based on comparison selecting a better of the blocks, discarding the block that was not selected, instructions to enable the system to compare the first portion, and discard one of the portions based on the comparison as this arrangement would facilitate the user to discard the unsatisfactory recording of the data and retain the good recording for his use as taught by Honma.

Regarding claim 59, Nishiuchi teaches the following: instructions to enable the block manager to discard a portion of the media stream that does not include the clip (see abstract).

5. Claims 7 and 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Matsumoto (JP 410055656A).

Regarding claims 7 and 16, Nishiuchi does not teach the following: audio comprises broadcast radio, media stream comprises a radio block and the block comprises a song.

However, Matsumoto discloses received information-recording system, which teaches the following: audio comprises broadcast radio, and media stream comprises a radio block and the block comprises a song (fig. 1, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: audio comprises broadcast radio and media stream comprises a radio block and the block comprises a song as this arrangement would enable the users to record radio programs as taught by Matsumoto.

6. Claims 12-13, 74-75, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiuchi in view of Hasegawa et al. (US PAT: 6,570,080, filed 5-18-2000, hereinafter Hasegawa).

Regarding claims 12-13, 74-75, Nishiuchi does not teach the following:
identifying the media content item corresponding to the clip, and obtaining the media content from a source which is different than the media stream, source is an on-line retailer. identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer.

However, Hasegawa discloses method and system for supplying contents via communication network which teaches the following: identifying the media content item corresponding to the clip, and obtaining the media content from a source which is different than the media stream, source is an on-line retailer (col. 2 lines 38-67, col. 3 lines 1-53).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: identifying the media content item corresponding to the clip, and obtaining the media content from a source which is different than the media stream, source is an on-line retailer as this

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arrangement would facilitate the user to obtain media content from the alternate sources as taught by Hasegawa, thereby providing user with choices.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiuchi in view of Perlman (US PAT: 6,125,259).

Regarding claim 19, Nishiuchi does not teach the following: the receiver is coupled to receive the media stream over a wired broadcast channel.

However, Perlman discloses intelligent and user friendly channel up/down control which teaches the following: the receiver is coupled to receive the media stream over a wired broadcast channel (col. 4 lines 43-61).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: the receiver is coupled to receive the media stream over a wired broadcast channel as this arrangement would provide another well known system to receive media stream as taught by Perlman.

8. Claims 67-68, are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma in view of Hasegawa.

Regarding claims 67-68, Honama does not teach the following: identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer.

However, Hasegawa teaches the following: identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer (col. 2 lines 38-67, col. 3 lines 1-53).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Honma's system to provide for the following: identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer as this arrangement would facilitate the user to obtain media content from the alternate sources as taught by Hasegawa, thereby providing user with choices.

9. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honma in view of Kim et al. (US PAT: 6,163,508, hereinafter Kim).

Regarding claim 69, Honma does not explicitly teach the following: during play of a particular block at a point after the start of a the particular block, receiving a signal to record the clip.

However, Kim discloses recording method having temporary buffering which teaches the following: during play of a particular block at a point after the start of a the particular block, receiving a signal to record the clip (fig. 1, col. 4 lines 2-4, and fig. 2).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Honma's system to provide for the following: during play of a particular block at a point after the start of a the particular block, receiving a signal to record the clip as this arrangement would facilitate the user to record the music after listening to it for a while, thus facilitating the user to selectively record music that satisfies his/or her taste.


Response to Arguments

10. Applicant's arguments with respect to claims 1-20, 57-70 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on M-F 6:30-4:00; every other F Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2643